



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,135	10/20/2001	Bruce N. Ames	B00-001-2	7465

23379 7590 07/15/2003

RICHARD ARON OSMAN
SCIENCE AND TECHNOLOGY LAW GROUP
75 DENISE DRIVE
HILLSBOROUGH, CA 94010

EXAMINER

JONES, DWAYNE C

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 07/15/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,135	AMES ET AL.	
Examiner	Art Unit	1614	
Dwayne C Jones			

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 62-131 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 62-131 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s) _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Status of Claims

1. Claims 62-131 are pending.
2. Claims 62-131 are rejected.
3. Claims 1-61 were cancelled as per applicants' response of March 17, 2003.

Election/Restrictions

4. The amendment filed on March 17, 2003 canceling all claims drawn to the non-elected invention and presenting only claims drawn to an elected invention is noted and considered.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 65-115 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason supports this rejection. The generic hydroxylamine compound of $\text{NHOHCR}_1\text{R}_2\text{R}_3$ only defines the three variables of R_1 , R_2 and R_3 in claim 64. Claims 65-115 recite the limitation "R" in each of these claims. There is insufficient antecedent basis for this limitation in the claim because the compound of claim 64 does not use the variable of R nor does this claim define it. Accordingly, these claims are rendered vague and indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 62 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Krishna, M.C. et al. Krishna, M.C. et al. teach of monitoring and assessing the cytoprotective effects of nitroxides as well as hydroxylamine and amine precursors by using a screening or assay method to determine the antioxidant and cytoprotective properties of nitroxides as well as hydroxylamine and amine precursors for mammalian cells, (see abstract).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 62-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishna, M.C. et al. Krishna, M.C. et al. teach of monitoring and assessing the cytoprotective effects of nitroxides as well as hydroxylamine and amine precursors by using a screening or assay method to determine the antioxidant and cytoprotective properties of nitroxides as well as hydroxylamine and amine precursors for mammalian cells, (see abstract). It is well known in the art that the nitroxides as well as hydroxylamine and amine precursors protect the cells due to oxidative damage causing agents, such as H_2O_2 . Clearly, it would have been obvious to the ordinary artisan to employ the teachings of Krishna, M.C. et al. namely assessing the cytoprotective effects of nitroxides as well as hydroxylamine and amine precursors against oxidative damage from oxidative insults, which are caused by oxidative damage causing agents, such as H_2O_2 . The skilled artisan is provided with the necessary motivation to utilize the teachings of Krishna, M.C. et al. develop method for monitoring and screening the cytoprotective effects of nitroxides as well as hydroxylamine and amine precursors by

Art Unit: 1614

using a screening or assay method to determine the antioxidant and cytoprotective properties of nitroxides as well as hydroxylamine and amine precursors for mammalian cells. Furthermore, the prior art reference of Krishna, M.C. et al. provide the skilled artisan with the motivation to employ these screening methods in response to various conditions or disease states where there is an increase or a greater susceptibility to oxidative insults, such as ischemia and reperfusion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (703) 308-4634. The examiner can normally be reached on Mondays through Fridays from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

1235.

DWAYNE C. JONES
PRIMARY EXAMINER

Tech. Ctr. 1614
July 12, 2003